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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,669	10/23/2003	Matthew Lerner	003797.00675	5871

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WASHINGTON, DC 20005-4051

EXAMINER
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RUTLEDGE, AMELIA L

ART UNIT	PAPER NUMBER
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2176

MAIL DATE	DELIVERY MODE
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09/06/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/690,669

Applicant(s)

LERNER ET AL.

Examiner

Amelia Rutledge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,8,11-13,21,24,26,27,35,38 and 40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8,11-13,21,24,26,27,35,38 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to communications: Amendment, filed 06/18/2007;  
Request for Continued Examination, filed 06/18/2007.
2. Claims 1, 8, 11-13, 21, 24, 26, 27, 35, 38 and 40 are pending in the case.  
Claims 1, 13, and 27 are independent claims.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/18/2007 has been entered.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:  
  
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. **Claims 1, 8, 11-13, 21, 24, 26, 27, 35, 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moran, U.S. Patent No. 6,509,912, issued**

**January 2003, in view of Maxted, U.S. Patent No. 6,340,967 B1, issued January 2002.**

**Regarding independent claim 1**, Moran teaches domain objects, programmatically equivalent to the claimed property values, which are context specific representations of information that are used in a freeform graphics system (Abstract, Figs. 22 and 26, col. 2, l. 28-57; col. 13, l. 13-col. 14, l. 23; claim 1), and that domain objects are represented in the system by a graphic object, i.e., icon, representing an instance of the domain object.

Moran teaches a storage, access, and rendering system for the domain objects (col. 6, l. 20-col. 7, l. 25), compare to claim 1, *a storage system that stores the property value of the document or file in electronic ink format; and an ink access system that allows the operating system to access the stored property value in electronic ink format, wherein the rendering system renders the stored property value in electronic ink format as part of a file preview operation.*

Moran teaches that the property value in electronic ink format includes an electronic ink title for the document or file (col. 13, l. 13-col. 14, l. 23; especially col. 14, l. 5-6; col. 21, l. 52-60), and that the title may be rendered as part of a file list operation (col. 10, l. 60-col. 11, l. 31). Moran teaches that the title may be rendered as part of a file preview operation (col. 13, l. 20-29), since Moran discloses that the user may expand the information about a domain object by double tapping on the icon, this will result in another layout of the domain object being displayed as an overlay, i.e., file preview.

Moran teaches that the system receives a property value of a document or file on the system in electronic ink format (col. 21, l. 25-51; col. 22, l. 8-23). Moran teaches that the property value is received as part of a file or document save operation because Moran teaches that system operations can be associated with user actions and the class definition of a domain object (col. 9, l. 50-col. 10, l. 10), therefore Moran suggests that the domain objects, i.e., property values may be received as part of a file or document save operation. While Moran does not explicitly teach *a rendering system for rendering a save interface in response to the input system receiving the save command, the input system configured to receive in electronic ink format a property value of a document or file on or accessible by the computer system in the save interface*; Maxted teaches a pen based edit correction interface method and apparatus which allows a user to enter electronic ink data into a window interface as part of a file save operation, in this case modifying a user defined dictionary (Fig. 14; col. 13, l. 47-col. 14, l. 67, especially col. 14, l. 4-13).

Both Moran and Maxted are directed toward pen based computer systems. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the user defined dictionary disclosed by Maxted with the freeform graphics system and domain objects disclosed by Moran, in order to improve recognition of specialty words, i.e., words not found in the default dictionary, and allowing the user to add those specialty words to a user defined dictionary (Maxted col. 34, l. 1-12), thereby allowing for greater customization of the freeform graphics system.

**Regarding dependent claim 8**, Moran teaches that the input system is activated in response to a command from an application program requesting activation of electronic ink input with respect to at least one document or file in the application program, since Moran teaches that the freeform editing program requests activation of electronic ink input with respect to documents or files in the program (col. 6, l. 20-col. 7, l. 25).

**Regarding dependent claims 11 and 12**, Moran teaches that the input system receives from a user a change to the property value in electronic ink format associated with the document or file (col. 13, l. 13-col. 14, l. 23; claim 1), and that the property value in electronic ink format includes an electronic ink title (col. 13, l. 13-col. 14, l. 23; especially col. 14, l. 5-6; col. 21, l. 52-60).

**Regarding independent claim 13**, claim 13 reflects the methods implemented by the system as claimed in claim 1, and is rejected along the same rationale.

**Regarding dependent claim 21, 24, and 26**, claims 21, 24, and 26 reflect the methods implemented by the system as claimed in claims 8, 11, and 12, respectively, and are rejected along the same rationale.

**Regarding independent claim 27**, claim 27 reflects the computer-readable medium including computer-executable instructions used by the system as claimed in claims 1, 8, and 9, and is rejected along the same rationale.

**Regarding dependent claims 35, 38, and 40**, claims 35, 38, and 40 reflect the computer-readable medium including computer-executable instructions implemented by

the system claimed in claims 8, 11, and 12, respectively, and are rejected along the same rationale.

### ***Response to Arguments***

3. Applicant's arguments with respect to amended claims 1, 13, and 27 have been considered but are moot in view of the new ground(s) of rejection.

4. The new ground of rejection includes the Maxted patent, which is being relied upon to disclose the newly claimed limitations: ...a rendering system for rendering a save interface in response to the input system receiving the save command, the input system configured to receive in electronic ink format a property value of a document or file on or accessible by the computer system in the save interface (Claim 1).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia Rutledge whose telephone number is 571-272-7508. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR

*William L. Bashore*  
**WILLIAM BASHORE**  
**PRIMARY EXAMINER**